

**REMARKS**

Applicant thanks the Examiner for the thorough consideration given the present application.

Claims 1-3 and 5-11 are pending in the present application.

Reconsideration of the Application is respectfully requested in light of the following remarks.

**Claim Rejections Under 35 USC § 102**

Claim 1 stands rejected under 35 USC § 102(e) as being anticipated by U.S. Patent 6,282,161 to Son et al. ("Son"). This rejection is respectfully traversed.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating

to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. § 706(A), (E) (1994). Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. Rosco v. Mirro Lite, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, Dayco Products, Inc. v. Total Containment, Inc., 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

The Office Action indicates that Son discloses a tilt controlling method which involves tracking a focus error at the maximum value of an RF signal or at the minimum value of jitter when a focus is on, referencing Fig. 6, wherein signals S-inner or S-outer are detected where jitter is a minimum. Applicant respectfully disagrees with this interpretation of Son. Applicant respectfully submits that Son's detection, using displacement sensor 26, of S-track inner and S-track outer is not a detection of a track of a focus error. Son actually does the opposite of what is claimed in the sense that, as pointed out in the first full paragraph of col. 3 of Son, jitter is detected from a jitter detecting unit and, based on the detected jitter, the tracking and focus servo are operated to adjust the offset of the focus and the track servo so that the jitter of the reproducing signal is minimized. In other words, Son does not appear to track a focus error whatsoever.

Moreover, because Son does not detect a focus error, Son also does not detect a maximum and a minimum value of the not-detected focus error. Thus, Son does not disclose or suggest the positively claimed feature of detecting the maximum and minimum value of the focus error.

Additionally, Son does not calculate a variation per track of the not-detected focus error. Thus, Son does not disclose or suggest the positively recited feature of calculating a variation per track of the focus error. In this regard, the last step of Fig. 7 of Son is actually adjusting tilt of optical pickup by tilt control value, and, accordingly, Son does not perform a calculating step, in general, or as claimed. Further, whereas the second last step in Fig. 7 is a calculating step, the calculation is of a tilt control value, not a calculation of variation per track of a focus error, as claimed.

Accordingly, the Office Action does not make out a *prima facie* case of anticipation of the invention recited in claim 1 by Son.

Reconsideration and withdrawal of this rejection of claim 1 are respectfully requested.

### ***Claim Rejections Under 35 USC § 103***

Claims 2 and 3 stand rejected under 35 USC § 103(a) as being unpatentable over Son in view of JP 08185636 by Tanaka et al. ("Tanaka"). This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443,

1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the

PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Son fails to disclose the invention recited in claim 1 for reasons presented above. Additionally, Tanaka is not applied to remedy the aforementioned shortcomings of Son. Accordingly, even if one of ordinary skill in the art were properly motivated to modify Son in view of Tanaka, as suggested, the so-modified version of Son would not disclose, suggest, or otherwise render obvious, the claimed invention.

The Office Action also asserts that Son's Fig. 5, last step, discloses that a tilt reference is varied as much as the variation per track to control the tilt. Unfortunately, however, the last step of Fig. 5 deals with an adjustment based not on focus error, as claimed, but on detected jitter. So, Applicant respectfully submits that this basis of the rejection is also not proper.

The Office Action also relies on the abstract of Tanaka. Applicant has obtained an English language abstract of Tanaka from the Japanese Patent Office (JPO) Internet website and does not find a DC voltage, or a normalized DC component mentioned therein. A copy of the computer generated English language version of Tanaka obtained from the JPO Internet website is attached.

Moreover, the Office Action fails to provide objective factual evidence of proper motivation to modify Son in view of Tanaka, as suggested, because Son, the primary reference, is not directed to detecting a track of a focus error.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 2 and 3.

Reconsideration and withdrawal of this rejection of claims 2 and 3 are respectfully requested.

Claim 10 stands requested under 35 USC § 103(a) as being unpatentable over U.S. Patent 5,001,690 to Kamiya ("Kamiya") in view of U.S. Patent 5,627,808 to Haijar et al. ("Haijar"). This rejection is respectfully traversed.

Applicant respectfully submits that Kamiya, the primary reference, fails to disclose or suggest obtaining an FE track, as claimed. In this regard, reference is made to col. 4, lines 9-13 of Kamiya, which make it clear that Kamiya is directed to a tilt error circuit, not a focus error circuit, and that a focus error track is not disclosed or suggested by Kamiya.

Furthermore, Haijar does not disclose or suggest normalizing a detected FE track, as claimed. For example, Fig. 5 of Haijar merely discloses normalized tracking offset based on disc tilt – see col. 2, lines 5-7, for example, and col. 4, lines 22-29 – and does not disclose normalizing a detected focus error track, as claimed.

So, no matter how Kamiya is modified by Haijar, the so modified version of Kamiya will not disclose or suggest the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claim 10.

Reconsideration and withdrawal of this rejection of claim 10 are respectfully requested.

Claim 11 stands rejected under 35 USC § 103(a) as being unpatentable over Son in view

of U.S. Patent 5,805,543 to Takamine et al. ("Takamine"). This rejection is respectfully traversed.

For reasons discussed above, Applicant respectfully submits that Son does not disclose or suggest controlling anything, including tilt, using a focus error signal by using maximum and minimum values of the focus error. In this regard, Son's tilt controlling block, said to be elements 28, 30, 36 and 40, is not disclosed as using maximum and minimum values of the focus error.

Additionally, Applicant respectfully submits that Son fails to disclose or suggest the claimed RF peak detecting block, which the Office Action asserts is element 32. In this regard, Son merely discloses that element 32 is a reproducing signal generator (see col. 4, lines 30-56), Applicant also respectfully submits that Son fails to disclose or suggest the claimed detecting block for detecting the maximum and minimum values of a focus error per one rotation of a disk, for reasons similar to those presented in the traversal of the rejection of claim 1, above.

Thus, even if one of ordinary skill in the art were properly motivated to modify Son in view of Takamine, as suggested, the resulting modified version of Son would not disclose, suggest, or otherwise render obvious, the invention recited in claim 11.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claim 11.

Reconsideration and withdrawal of this rejection of claim 11 are respectfully requested.



***Allowable Subject Matter***

The Examiner states that claims 5-9 would be allowable if rewritten in independent form.

Applicant thanks the Examiner for the indication of allowable subject matter in this application. However, claims 5-9 are believed to be allowable at least because they depend from claim 1, which Applicant respectfully submits is allowable for reasons presented above. Claims 5-9 are also believed to be allowable because of the subject matter recited therein. Accordingly, claims 5-9 have not been re-written in independent form.

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***Conclusion***

Applicant respectfully petitions under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a one-month extension of time to September 16, 2007 in which to respond to the Examiner's Office Action.

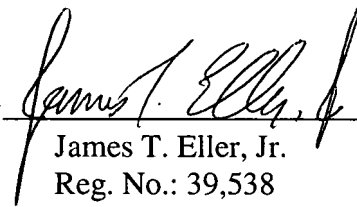
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: **September 17, 2007 (Monday)**

Respectfully submitted,

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Enclosure: JPO Computer Generated English Language Translation of JP 08-185636